



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Steven W. Trovinger) Group Art Unit: 3651
Application No.: 10/698,504) Examiner: Patrick H. Mackey
Filed: October 30, 2003) Confirmation No.: 9590
For: METHOD AND APPARATUS FOR)
MAKING BOOKLETS)

**PETITION UNDER 37 C.F.R. § 1.78(a)(3) TO ACCEPT AN UNINTENTIONALLY
DELAYED REFERENCE UNDER 35 U.S.C. § 120 AND/OR § 365**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.78(a)(3), Applicant hereby requests the U.S. Patent and Trademark Office to accept the unintentionally delayed reference to the claim under 35 U.S.C. § 120 and/or § 365 in this application.

In accordance with 37 C.F.R. § 1.78(a)(3)(i), the reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2) is concurrently submitted in the accompanying Response to the Official Action dated April 30, 2004.

In accordance with 37 C.F.R. § 1.78(a)(3)(ii), a fee of \$1,330.00 is required under 37 C.F.R. § 1.17(t). The Director is hereby authorized to charge Deposit Account No. 08-2025 for the fee due.

DOCKETED
filed 7-16-04 CS

On information and belief, the entire delay between the date the reference to the claim under 35 U.S.C. § 120 and/or § 365 was due under 37 C.F.R. § 1.78(a)(2)(ii) and the date the reference required by 37 C.F.R. § 1.78(a)(2) is submitted in this application was unintentional. The following facts are presented in support of this Petition.

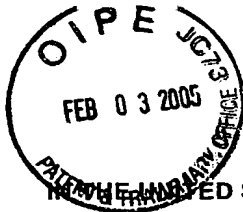
1. The present application is a divisional application of parent Application Serial No. 09/831,768. The parent Application Serial No. 09/831,768, was filed as a § 371 national stage application of International Application No. PCT/US99/23078, which is also a Continuation-in-Part Application of U.S. Application No., 09/162,844, filed on September 29, 1998.
2. The specification in parent Application Serial No. 09/831,768 did NOT contain a reference to the prior filed applications, because no such reference was required. The International Application was filed on September 29, 1999, and was therefore exempted per 37 C.F.R. 1.78(a)(2)(ii)(C) from the requirements of 37 C.F.R. §1.78 when the International Application was nationalized.
3. The present divisional application made a claim for priority to parent Application Serial No. 09/831,768, in the transmittal and to the International Application No. PCT/US99/23078 and to Continuation-in-Part Application No., 09/162,844, in the originally filed Declaration (see Attachment A). The present divisional application was filed on October 30, 2003, with a photocopy of the original specification of Application Serial No. 09/831,768.
4. Because the original specification of parent Application No. 09/831,768 did not contain a cross-reference to the International Application or CIP Application, the photocopy of the parent used to file the present divisional application did not contain a cross-reference to the International Application.
5. The present application was amended at the time of filing to include a cross-reference to Application Serial No. 09/831,768 (see Preliminary Amendment Attachment B). However, a cross-reference to the International Application and CIP Application was unintentionally not included in the Preliminary Amendment.
6. Upon becoming aware of the failure to timely meet the requirements of 37 C.F.R. §1.78, we promptly prepared and submitted this Petition to make the cross-reference to the International Application and CIP Application on page 1 of the specification in the present divisional application.

Accordingly, because all requirements for a proper Petition Under 37 C.F.R. §1.78 have been satisfied, granting of this Petition to recognize Applicant's claim for priority to the International Application is requested.

Date: July 16, 2009



Patrick C. Keane



Patent
Attorney Docket No. 032842-180

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Steven W. Trovinger

Group Art Unit: 3651

Application No.: 10/698,504

Examiner: Patrick Hewey Mackey

Filing Date: October 30, 2003

Confirmation No.: 9590

Title: METHOD AND APPARATUS FOR MAKING BOOKLETS

**REQUEST FOR WITHDRAWAL OF HOLDING OF
ABANDONMENT - NO ABANDONMENT IN FACT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with M.P.E.P. § 711.03, withdrawal of the holding of abandonment in the above-captioned application is respectfully requested, there being no abandonment in fact. Specifically, the Notice of Abandonment issued on February 11, 2005 states that the application is held abandoned for failure to respond to the Patent and Trademark Office communication dated April 16, 2004.

However, a reply to that communication was timely filed on July 16, 2004. A copy of that reply (i.e., the reply dated July 16, 2004) is enclosed, as is a copy of a postcard receipt date-stamped by the Patent and Trademark Office acknowledging receipt of said reply on said date. This date-stamped postcard receipt, which itemizes and properly identifies the papers filed, is prima facie evidence of receipt in the Patent and Trademark Office of all the items listed thereon on the date stamped thereon by the Patent and Trademark Office. See, M.P.E.P. § 503.

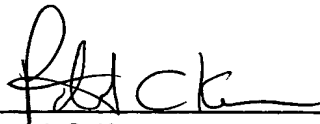
In light of the above, withdrawal of the holding of abandonment and prompt and favorable action on the merits are respectfully requested.

It is believed that no fee is required for consideration of this paper. Should the Office deem otherwise, the Director is hereby authorized to charge any appropriate fees under 37 C.F.R. § 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By


Patrick C. Keane
Registration No. 32,858

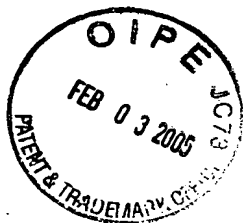
Date: March 3, 2005

Date: March 3, 2005

I hereby certify that this document is being filed by personal delivery to the Customer Service Window Randolph Building, 401 Dulany Street Alexandria, VA 22314, of the United States Patent & Trademark Office on the date indicated above.

By:  Reg No 32,858
(Attorney Signature and Reg. No.)

**REQUEST FOR WITHDRAWAL OF HOLDING OF
ABANDONMENT - NO ABANDONMENT IN FACT**



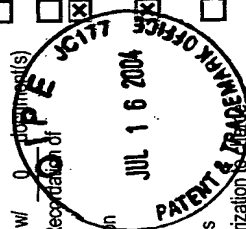
49

Patent Response Postcard

Inventor: Steven W. Trovinger Appl. No.: 10/698,504 Filing Date: October 30, 2003
 Docket No.: 10991471-13 (-180) Working Atty.: JGK/geh Date: July 16, 2004
 Dkt. Clerk/Initials: 032842-80

The following was/were received in the U.S. Patent and Trademark Office on the date stamped hereon:

- | | | |
|--|--|---|
| <input checked="" type="checkbox"/> Amendment or Response | <input type="checkbox"/> Executed Declaration/Power of Attorney | <input type="checkbox"/> Request for Corrected Filing Receipt w/copy of Official Filing Receipt |
| <input type="checkbox"/> Preliminary Amendment | <input type="checkbox"/> Assignment/Assignment Recordation Form Cover Sheet (PTO-1595) | <input type="checkbox"/> Substitute Specification (clean/markd copies) |
| <input checked="" type="checkbox"/> Amendment/Reply Transmittal Letter | <input type="checkbox"/> Submission of Certified Copy of Priority Document w/ <u>0</u> certified copy(ies) | <input type="checkbox"/> Check for \$ <u> </u> is enclosed |
| <input type="checkbox"/> Petition for <u> </u> Month Extension of Time | <input type="checkbox"/> Information Disclosure Statement Transmittal | <input type="checkbox"/> Check for \$ <u> </u> is enclosed |
| <input type="checkbox"/> Submission of Formal Drawings w/ <u> </u> sheet(s) of drawings (Fig(s). 1- <u> </u>) | <input checked="" type="checkbox"/> Information Disclosure Citation (PTO-1449) | <input checked="" type="checkbox"/> Charge \$ <u> </u> to Deposit Account |
| <input type="checkbox"/> Request for Approval of Drawing Changes w/ <u> </u> sheet(s) of red ink drawings | <input checked="" type="checkbox"/> Information Disclosure Statement w/ <u>0</u> <u> </u> (s) | <input type="checkbox"/> Charge \$ <u> </u> to credit card. Form PTO-2038 is attached. |
| <input type="checkbox"/> Notice of Appeal | <input type="checkbox"/> Request for Corrected Notice of Recordation of Assignment w/Copy of Notice | <input type="checkbox"/> Filed by Certificate of Mail |
| <input type="checkbox"/> Brief for Appellant | <input type="checkbox"/> Request for Continued Examination | <input checked="" type="checkbox"/> Charge \$1,510.00 to Deposit Acct. No. 08-2025 |
| <input type="checkbox"/> Request for Oral Hearing | <input type="checkbox"/> Issue Fee Transmittal | <input type="checkbox"/> Petition Under 37 C.F.R. 1.78(a)(3) to Accept an Unintentionally Delayed Reference |
| <input type="checkbox"/> Reply Brief | <input type="checkbox"/> Status Inquiry | |
| <input type="checkbox"/> Response to Restriction Requirement or Election of Species | <input type="checkbox"/> Submission of Corrected Drawings | |
| <input type="checkbox"/> Terminal Disclaimer | <input type="checkbox"/> Payment of Issue Fee and Authorization to Deposit Account | |
| <input type="checkbox"/> Certificate Under 37 C.F.R. 3.73(b) | <input type="checkbox"/> Request for Refund | |
| <input type="checkbox"/> Transmittal Letter for Missing Parts of Application | | |



If submitting documents via Express Mail, provide the Express Mailing Label No. below:

Express Mail Mailing Label No.

DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATIONATTORNEY DOCKET NO. 10991471-1

FEB 03 2005

As a below named inventor, I hereby declare that:

My residence/post office address and citizenship are as stated below next to my name:

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Method And Apparatus For Making Booklets

the specification of which is attached hereto unless the following box is checked:

(X) was filed on Sep 29, 1999 as US Application Serial No. or PCT International Application Number US99/23078 and was amended on _____ (if applicable).

I hereby state that I have reviewed and understood the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.

Foreign Application(s) and/or Claim of Foreign Priority

I hereby claim foreign priority benefits under Title 35, United States Code Section 119 of any foreign application(s) for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate having a filing date before that of the application on which priority is claimed:

COUNTRY	APPLICATION NUMBER	DATE FILED	PRIORITY CLAIMED UNDER 35 U.S.C. 119
PCT	PCT/US99/23078	09/29/99 <i>G</i>	YES: <u>X</u> NO: _____
			YES: _____ NO: _____

Provisional Application

I hereby claim the benefit under Title 35, United States Code Section 119(e) of any United States provisional application(s) listed below:

APPLICATION SERIAL NUMBER	FILING DATE

U. S. Priority Claim

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

APPLICATION SERIAL NUMBER	FILING DATE	STATUS (patented/pending/abandoned)
09/162844	09/29/1998	Pending

POWER OF ATTORNEY:

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Customer Number 022879Place Customer
Number Bar Code
Label hereSend Correspondence to:
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80528-9599

Direct Telephone Calls To:

Edward Maker II
(650) 857-5143

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Inventor: Steven W TrovingerCitizenship: USResidence: 1099 Parma Way Los Altos, CA 94204Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304*Steven W Trovinger*

Inventor's Signature

Date

11/23/99

DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATION (continued)

ATTORNEY DOCKET NO. 10991471-1

Full Name of # 2 joint inventor: Ross R Allen Citizenship: US
Residence: 408 Hainline Dr Belmont CA 94002
Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304
Inventor's Signature: [Signature] Date: 12/3/92

Full Name of # 3 joint inventor: Erik G Vaaler Citizenship: US
Residence: 707 Leahy Street # 216-B Redwood City, CA 94061
Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304
Inventor's Signature: [Signature] Date: 11/24/99

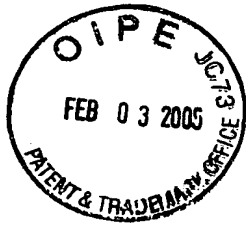
Full Name of # 4 joint inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 5 joint inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 6 joint inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 7 joint inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____

Full Name of # 8 joint inventor: _____ Citizenship: _____
Residence: _____
Post Office Address: _____
Inventor's Signature: _____ Date: _____



PRELIMINARY AMENDMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Steven W. Trovinger
Serial No.: 09/831,768

Group Art Unit: not available
Examiner: not available

Filed: May 14, 2001

Title: Method and Apparatus for Making Booklets

Atty Docket: 10991471-9

PRELIMINARY AMENDMENT

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

Please consider the following preliminary amendment in connection with the divisional application of the above-noted application filed herewith.

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 4 of this paper.

Amendments to the Specification

Page 1 of the application, after the Title please insert the following paragraph:

CROSS-REFERENCES TO RELATED APPLICATIONS

This application is a divisional of prior Application No. 09/831,768 filed May 14, 2001.

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the present application:

Listing of Claims:

Claims 1-39 (cancelled)

Claim 40 (currently amended) ~~The method of claim 37 including the step of~~ Method for stacking sheets of printing media, comprising the steps of:

- a) collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein;
- b) registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet and punching a hole in the sheets, sheet-by-sheet;
- c) unloading the stack of collected and registered sheets from the workpiece.

Claim 41 (currently amended) ~~The method of claim 37 including the step of~~ Method for stacking sheets of printing media, comprising the steps of:

- a) collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein;
- b) registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet and cutting out a notch in selected sheets, sheet-by-sheet;
- c) unloading the stack of collected and registered sheets from the workpiece.

Claims 42-62 (cancelled)

REMARKS

Applicant respectfully requests consideration of the above preliminary amendment.

Amendments to the Specification

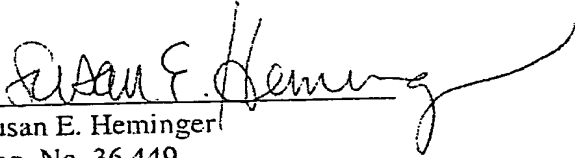
The present application is a divisional of an original parent application. A section entitled "CROSS-REFERENCES TO RELATED APPLICATIONS" has been added after the title indicating that the present application is a divisional of prior Application No. 09/831,768 filed May 14, 2001.

Amendments

Claims 1-39 and 42-62 are cancelled and Claims 40 and 41 are remaining.

Respectfully submitted,

Steven W. Trovinger

By 
Susan E. Heminger
Reg. No. 36,449

October 27, 2003
Hewlett-Packard Company
Legal Department IPA
P.O. Box 272400
Fort Collins, CO 80527-2400

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Steven W. TROVINGER

Application No.: 10/698,504

Filing Date: Oct. 30, 2003

Title: METHOD AND APPARATUS FOR MAKING BOOKLETS

Confirmation No.: 9590

Examiner:
Patrick H. Mackey

Group Art Unit: 3651

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Sir:

This Information Disclosure Statement is submitted:

- () under 37 CFR 1.97(b), or
(Within three months of filing national application; or date of entry of national application; or before mailing date of first office action on the merits; whichever occurs last)
- (X) under 37 CFR 1.97(c) together with either a:
() Statement under 37 CFR 1.97(e), or
(X) a \$180.00 fee under 37 CFR 1.17(p), or
(After the CFR 1.97 (b) time period, but before final action or notice of allowance, whichever occurs first)
- () under 37 CFR 1.97 (d) together with a:
() Statement under 37 CFR 1.97(e)(1) or (2), and
() a \$180.00 fee set forth in 37 CFR 1.17(p).
(Filed after final action, a notice of allowance, on or before payment of the issue fee)

Please charge to Deposit Account 08-2025 the sum of \$180.00. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25.

(X) Applicant(s) submit herewith Form PTO 1449 - Information Disclosure Statement together with any required copies of patents, publications or other information of which applicant(s) are aware, which applicant(s) believe(s) may be material to the examination of this application and for which there may be a duty to disclose in accordance with 37 CFR 1.56.

() A concise explanation of the relevance of foreign language patents; foreign language publications and other foreign language information listed on PTO Form 1449, as presently understood by the individuals(s) designated in 37 CFR 1.56 (c) most knowledgeable about the content is given on the attached sheet, or where a foreign language patent is cited in a search report or other action by a foreign patent office in a counterpart foreign application, an English language version of the search report or action which indicates the degree of relevance found by the foreign office is listed on form PTO 1449 and is enclosed herewith.

It is requested that the information disclosed herein be made of record in this application.

Date: 16 July 2004

I hereby certify that this document is being filed by personal delivery to the Customer Service Window, Crystal Plaza 2, 1B03 220 20th Street S, Arlington Virginia, 22202 of the United States Patent & Trademark Office on the date indicated above.

By: [Signature] 50,491

(Attorney Signature and Reg. No.)

Respectfully submitted,

Steven W. TROVINGER

By [Signature]

Patrick C. Keane

Attorney/Agent for Applicant(s)

Reg. No. 32,858

Date: July 16, 2004

Telephone No.: (703) 836-6620



PATENT APPLICATION

Sheet 1 of 3

FORM PTO-1449

LIST OF PATENTS AND PUBLICATIONS FOR
APPLICANT'S INFORMATION DISCLOSURE
STATEMENT

(Use several sheets if necessary)

DOCKET NO.

10991471-13

APPLICATION NO.

10/698,504

CONFIRMATION NO.

9590

APPLICANT

Steven W. TROVINGER

FILING DATE

Oct. 30, 2003

GROUP

3651

REFERENCE DESIGNATION

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	PUBLICATION DATE	NAME	Pages, Columns, Lines Where Relevant Passages or Figures Appear
	1A	4,053,150	Oct. 11, 1977	LANE	
	1B	5,087,163	Feb. 11, 1992	ERDBORIES et al.	
	1C	5,346,350	Sep. 13, 1994	LUHMAN et al.	
	1D	5,452,920	Sep. 26, 1995	PARKER	
	1E	5,465,213	Nov. 7, 1995	ROSS	
	1F	6,193,458 B1	Feb. 27, 2001	MARSH	
	1G	6,363,851 B1	Apr. 2, 2002	GERHARD et al.	
	1H	2002/0140154	Oct. 3, 2002	TROVINGER	
	1I	2002/0146302	Oct. 10, 2002	TROVINGER	
	1J	5,810,346	Sep. 22, 1998	JORG	
	1K	5,456,646	Oct. 10, 1995	CROWLEY	

FOREIGN PATENT DOCUMENTS

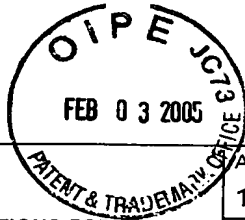
		DOCUMENT NUMBER	PUBLICATION DATE	NAME OF PATENTEE OR APPLICANT	Pages/Columns/Lines Where Relevant Passages/Figures Appear	Check if Translation attached
	1L					
	1M					
	1N					
	1O					
	1P					

OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, etc.)

1Q	U.S. Patent Application No. 10/084,460 filed February 28, 2002, entitled "Booklet Maker", Steven W. Trovinger.
1R	U.S. Patent Application No. 10/231,127 filed August 30, 2002, entitled "Booklet Maker and Method of Manufacturing A Booklet Maker", Steven W. Trovinger.
1S	U.S. Patent Application No. 09/970,730 filed October 5, 2001, entitled "Sheet Folding Apparatus", Steven W. Trovinger et al.

EXAMINER

DATE CONSIDERED



PATENT APPLICATION

Sheet 2 of 3

FORM PTO-1449

LIST OF PATENTS AND PUBLICATIONS FOR
APPLICANT'S INFORMATION DISCLOSURE
STATEMENT

(Use several sheets if necessary)

ATTY. DOCKET NO.

10991471-13

APPLICATION NO.

10/698,504

CONFIRMATION NO.

9590

APPLICANT

Steven W. TROVINGER

FILING DATE

Oct. 30, 2003

GROUP

3651

REFERENCE DESIGNATION

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	PUBLICATION DATE	NAME	Pages, Columns, Lines Where Relevant Passages or Figures Appear
	2A	5,632,587	May 27, 1997	COYETTE	
	2B	4,795,071	Jan. 3, 1989	JACOBS et al.	
	2C	4,575,296	Mar. 11, 1986	KOCKLER et al.	
	2D	4,484,501	Nov. 27, 1984	RAMCKE	
	2E	4,891,681	Jan. 2, 1990	FISKE et al.	
	2F	5,803,891	Sep. 8, 1998	HAAN et al.	
	2G	3,897,051	July 29, 1975	MULLER	
	2H	4,595,187	Jun. 17, 1986	BOBER	
	2I	5,076,556	Dec. 31, 1991	MANDEL	
	2J	5,445,592	Aug. 29, 1995	RICHARDS	
	2K	4,640,611	Feb. 3, 1987	OHDAKE et al.	

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	PUBLICATION DATE	NAME OF PATENTEE OR APPLICANT	Pages/Columns/Lines Where Relevant Passages/Figures Appear	Check if Translation attached
	2L					
	2M					
	2N					
	2O					
	2P					

OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, etc.)

	2Q	P. Berger, "Investieren Mt Blick Auf Digitale Nischenprodukte" (in German), Vol. 34, No. 5, Sept. 17, 1998, page 45, Deutscher Drucker.
	2R	
	2S	

EXAMINER

DATE CONSIDERED



FORM PTO-1449

LIST OF PATENTS AND PUBLICATIONS FOR
APPLICANT'S INFORMATION DISCLOSURE
STATEMENT

(Use several sheets if necessary)

ATTY. DOCKET NO.

10991471-13

APPLICATION NO.

10/698,504

CONFIRMATION NO.

9590

APPLICANT

Steven W. TROVINGER

FILING DATE

Oct. 30, 2003

GROUP

3651

REFERENCE DESIGNATION

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	PUBLICATION DATE	NAME	Pages, Columns, Lines Where Relevant Passages or Figures Appear
	3A	5,377,965	Jan. 3, 1995	MANDEL et al.	
	3B	5,241,474	Aug. 31, 1993	MAROVAC	
	3C	5,108,082	Apr. 28, 1992	SHEA et al.	
	3D				
	3E				
	3F				
	3G				
	3H				
	3I				
	3J				
	3K				

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	PUBLICATION DATE	NAME OF PATENTEE OR APPLICANT	Pages/Columns/Lines Where Relevant Passages/Figures Appear	Check if Translation attached
	3L					
	3M					
	3N					
	3O					
	3P					

OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, etc.)

	3Q	
	3R	
	3S	

EXAMINER

DATE CONSIDERED

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Steven W. TROVINGER

Confirmation No.: 9590

Application No.: 10/698,504

Examiner: Patrick H. Mackey

Filing Date: Oct. 30, 2003

Group Art Unit: 3651

Title: METHOD AND APPARATUS FOR MAKING BOOKLETS

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment () Petition to extend time to respond
() New fee as calculated below () Supplemental Declaration
(X) No additional fee
(X) Other: Petition (fee \$ 1,330.00)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$18	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$86	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$280	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$420.00	3RD MONTH \$950.00	4TH MONTH \$1480.00		\$ 0
OTHER FEES						\$ 1,330
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 1,330

Charge \$ 1,330 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

Date: July 16, 2004

I hereby certify that this document is being filed by personal delivery to the Customer Service Window, Crystal Plaza 2, 1B03 220 20th Street S, Arlington Virginia, 22202 of the United States Patent & Trademark Office on the date indicated above.

By: Patrick C. Keane Reg. No. 32,858
(Attorney Signature and Reg. No.)

Respectfully submitted,

Steven W. TROVINGER

By: Patrick C. Keane

Patrick C. Keane

Attorney/Agent for Applicant
Reg. No. 32,858

Date: July 16, 2004

Telephone No.: (703) 836-6620

Date: July 16, 2004

I hereby certify that this document is being filed by personal delivery to the Customer Service Window, Crystal Plaza, 20th Street S, Arlington, Virginia, 22202 of the United States Patent & Trademark Office on the date indicated above.

(Attorney Signature and Reg. No.)

Patent
Attorney's Docket No. 10991471-13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)

Steven W. TROVINGER)

Application No.: 10/698,504)

Filed: October 30, 2003)

For: METHOD AND APPARATUS FOR)
MAKING BOOKLETS)

Group Art Unit: 3651

Examiner: Patrick H. Mackey

Confirmation No.: 9590

AMENDMENT PURSUANT TO 37 C.F.R. §1.111

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Official Action mailed April 16, 2004, please amend the
above-identified patent application as follows:

DOCKETED
filed 7-16-04

AMENDMENTS TO THE SPECIFICATION:

Please replace the first paragraph after the title with the following paragraph:

CROSS-REFERENCE TO RELATED APPLICATIONS

This application is a divisional of prior Application No. 09/831,768 filed May 14, 2001, which is a § 371 National Stage Application of PCT International Application No. PCT/US99/23078 filed September 29, 1999, which International Application was published by the International Bureau in English on April 6, 2000, which is a Continuation-in-Part Application of U.S. Application No., 09/162,844, filed on September 29, 1998, now abandoned.

AMENDMENTS TO THE CLAIMS:

This listing of claims will replace all prior versions, and listings, of claims in the application:

LISTING OF CLAIMS:

Claims 1-39 (Canceled)

40. (Previously Presented) Method for stacking sheets of printing media, comprising the steps of:

- a) collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein;
- b) registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet and punching a hole in the sheets, sheet-by-sheet;
- c) unloading the stack of collected and registered sheets from the workpiece.

41. (Previously Presented) Method for stacking sheets of printing media, comprising the steps of:

- a) collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein;
- b) registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet and cutting out a notch in selected sheets, sheet-by-sheet;
- c) unloading the stack of collected and registered sheets from the workpiece.

Claims 42-62 (Canceled)

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 40 and 41 were pending. By the present response, the specification has been amended. Thus, upon entry of the present response, claims 40-41 remain pending and await further consideration on the merits.

CLAIM FOR BENEFIT OF EARLIER FILING DATE AND CROSS-REFERENCE TO RELATED APPLICATIONS

Enclosed herewith is a Petition Under 37 C.F.R. §1.78(a)(3) to Accept an Unintentionally Delayed Reference under 35 U.S.C. § 120 and/or § 365. The present amendment to the specification makes the cross-reference to related applications required under 37 C.F.R. §1.78. It is respectfully requested upon granting of the petition that this application be accorded the benefit of the earlier filing date, as provided under 35 U.S.C. §§ 363 and 365.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 40 and 41 stand rejected under 35 U.S.C. §102(a) as being anticipated by WO 00/40425 to Scholta (hereafter "*Scholta*") on the grounds set forth in paragraph 3 of the Official Action. This rejection is respectfully traversed.

1. The date of invention of the present application based on a perfected priority date is prior to the date the *Scholta* PCT reference is available as prior art

The rejections are respectfully traversed because the *Scholta* reference is not prior art to the present application under the statutory standards set out in 35 U.S.C. § 102 and its use in a rejection of the present claims is improper.

The present application was filed under 35 U.S.C. §371 and, under 35 U.S.C. §363, has an effective filing date in the U.S. Patent and Trademark Office that is the same as the international filing date, e.g., September 29, 1999. Further, the international application is a Continuation-in-Part Application of U.S. Application No., 09/162,844, filed on September 29, 1998. The *Scholta* reference has an international application filing date of December 23, 1999 and was published in a non-English language on July 13, 2000. Thus, the present application was filed prior to the international filing date of the *Scholta* reference and prior to the publication of the *Scholta* reference.

Because the *Scholta* patent is not available as prior art against the application, Applicant respectfully requests the withdrawal of the rejections. Accordingly, all pending claims are considered allowable.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 16, 2004

By: _____

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